



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: ASSISTANT COMMISSIONER FOR PATENTS

Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10/015,290	12/17/2001	Gusler, et al.	AUS920010918US1

IBM CORP.  
INTELLECTUAL PROPERTY LAW  
11400 BURNET ROAD  
AUSTIN, TX 78758

EXAMINER

ART UNIT

PAPER

DATE MAILED: 05/31/2005

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: ASSISTANT COMMISSIONER FOR PATENTS

Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10/015,290	12/17/2001	Gusler, et al.	AUS920010918US1

IBM CORP. (WIP)  
C/O WALDER INTELLECTUAL PROPERTY LAW, P.C.  
P.O. BOX 832745  
RICHARDSON, TX 75083

EXAMINER

ART UNIT

PAPER

DATE MAILED: 05/31/2005

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



IBM Corp.  
Intellectual Property Law  
11400 Burnet Road  
Austin, Texas 78758

In re U.S. Patent of: Carl P. Gussler et al.	)	
Application No. 10/015,290	)	
Filed: December 17, 2001	)	
For: Employing Speech Recognition and	)	
Capturing Customer Speech to Improve	)	<b>DECISION RETURNING</b>
Customer Service	)	<b>IMPROPER PRIOR ART</b>
		<b>CITATION UNDER 37 C.F.R. §</b>
		<b>1.501</b>

Receipt of a citation of prior art filed under 37 C.F.R. § 1.501 by the Applicant on April 25, 2005, in the above-identified application is hereby acknowledged. Because the prior art citation was filed before the date of the patent grant, it is not a proper submission under 37 C.F.R. § 1.501 and 35 U.S.C. § 301. Accordingly, the citation is being returned to the Applicant.

### BASIS OF THE DECISION

#### 35 U.S.C. § 301 Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular **patent**. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof **will become a part of the official file of the patent**. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

#### 37 C.F.R. § 1.501 Citation of prior art in patent files.

(a) At any time during **the period of enforceability of a patent**, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

### ANALYSIS

35 U.S.C. § 301 and 37 C.F.R. § 1.501(a) are reproduced above with emphasis added to highlight key phrases which inform this decision.

35 U.S.C. § 301 is a provision for citation of prior art which bears on “the patentability of any claim of a particular *patent*”. Such a citation “will become a part of the official file of the *patent*”. [Emphasis added].

The Office implemented this portion of the statute through 37 C.F.R. § 1.501 which is entitled “Citation of prior art in *patent* files” [Emphasis added]. Rule 501(a) sets the time during which a citation may be filed as “the period of enforceability of a patent”.

As of the date of this decision, the application under examination has not matured into a patent. Therefore, the submission of prior art under 37 C.F.R. 1.501 is not proper since it does not bear on a claim of a *patent* and there is no patent for which a period of enforceability applies.

### DECISION

Accordingly, the submission is being returned to Applicant’s representative. Applicant may resubmit the prior art citation under 501 after the patent issues or may consider submitting it, as an IDS which complies with rules 97 and 98, in the pending application.

Any inquiries with respect to this decision may be addressed to the undersigned.



Pinchus M. Laufer  
Special Programs Examiner  
Technology Center 2100  
Computer Architecture, Software, and Information Security  
(571) 272-3599

cc: IBM Corp. (WIP)  
c/o Walder Intellectual Property Law, P.C.  
P.O. Box 832745  
Richardson, Texas 75083